



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,408	04/09/2004	Kerry Sellen	1DATA.061A	8430
20995 7590 02/12/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER NGUYEN, HIEP VAN				
ART UNIT 4137		PAPER NUMBER		
NOTIFICATION DATE 02/12/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/821,408

Applicant(s)

SELLEN ET AL.

Examiner

HIEP NGUYEN

Art Unit

4137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) 31 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. Claims 1-55 have been examined.

Claim Objections

2. Claim 31 is objected to because of the following informalities: a special data base. Appropriate correction is required. The Examiner notes the typographical error made for the word "data base" on line 2 of this claim.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. In claims 1, 3-7, 9, 11 the limitation recites "the payment". Line 3 of claim 1 defines "a promissory payment." There is insufficient antecedent basis for this limitation in the claims. Examiner notes that "the payment" is intended for "the promissory payment."

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim1-55 are rejected under 35 U.S.C. 102(b) as being anticipated by

Templeton et al. (US 2003/0130919.)

5. With respect to claim 1, Templeton et al. teaches a method of processing electronic promissory payments made by a customer to a merchant, the method comprising:

- a. receiving an electronic representation of a promissory payment that includes an identification of the customer account and the merchant (Page 1, paragraph 0006, lines 2-5, Abstract, line4.)
- b. determining whether the payment can be submitted for subscriber settlement by evaluating a special rules database to determine whether the customer's transactions are subject to a special rule (Paragraph 0007, lines 6-7. Paragraph 0081, lines 1-15.)
- c. submitting the payment to the customer's financial institution electronically if it is determined that the customer's electronic representation is not subject to a special rule; and submitting the payment to the customer's financial institution according to the special rule if it is determined that the customer's electronic representation is subject to a special rule (Paragraph 0009, lines 1-15.)

6. With respect to claim 2, Templeton et al. evaluating the special rules database includes identifying the customer's financial institution associated with at least one of an account number, a routing number, and an alternative routing number (Paragraph 0081, lines1-15.)

7. With respect to claim 3, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises printing the electronic representation of the payment as a paper drafted check for submission to the clearing house (Paragraph 0160, lines 1-7.)

8. With respect to claim 4, Templeton et al. teaches submitting the payment to the customer's financial institution includes submitting the paper drafted check to the customer's financial institution (Paragraph 0157, lines 1-6, Paragraph 0160, lines 1-7.)

9. With respect to claim 5, Templeton et al. teaches submitting the payment to the customer's financial institution includes submitting a pre-authorized check or PAC item (Paragraph 0050, lines 1-15.)

10. With respect to claim 6, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises submitting the electronic representation of the payment to the customer's financial institution via a direct electronic access system (Paragraph 0089, lines 8-12, Paragraph 0058, lines 9-14.)

11. With respect to claim 7, Templeton et al. teaches submitting the payment to the customer's financial institution includes submitting the electronic representation of the payment to the customer's financial institution via the direct electronic access system (Paragraph 0058, lines 9-14.)

12. With respect to claim 8, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises the use of an alternative routing transit number (Paragraph 0088, lines 1-8.)

13. With respect to claim 9, Templeton et al. teaches submitting the payment includes submitting the payment to the customer's financial institution using the alternative routing transit number (Paragraph 0089, lines 9-12.)
14. With respect to claim 10, Templeton et al. teaches evaluating the special rules database includes determining if the special rule comprises the use of an alternative account number (Paragraph 0088, lines 1-8.)
15. With respect to claim 11, Templeton et al. teaches submitting the payment includes submitting the payment to the customer's financial institution using the alternative account number (Paragraph 0088, lines 1-8.)
16. With respect to claim 12, Templeton et al. teaches receiving electronic promissory payments comprises generating an electronic profile relating to the customer using electronic check conversion (Paragraph 0162, lines 1-10.)
17. With respect to claim 13, Templeton et al. teaches submitting the customer's electronic representation to the customer's financial institution comprises transferring funds from the customer's account using electronic fund transfer (Paragraph 0058, lines 9-14.)
18. With respect to claim 14, Templeton et al. teaches submitting the customer's electronic representation to the customer's financial institution directly comprises transferring funds from the customer's account direct connect, On-Us processing (Paragraph 0058.)

19. With respect to claim 15, Templeton et al. teaches the method further comprises performing a risk assessment relating to processing electronic promissory payments using the electronic representations of the promissory payments (Abstract, lines 1-6.)

20. With respect to claim 16, Templeton et al. teaches updating the special rules database in a manner so as to record previous submissions by the customer (Paragraph 0081, lines 1-15.)

21. With respect to claim 17, Templeton et al. teaches a method of settling a financial transaction between a customer and a merchant using a routing mechanism (Paragraph 0089, lines 1-13), the method comprising:

acquiring an electronic profile relating to the customer, wherein the electronic profile can be used to transfer funds from the customer's financial institution (Paragraph 0025, lines 1-4);

evaluating the electronic profile using a special rules database having previously stored electronic information relating to the customer in a manner so as to identify a special rule; and requesting settlement of the financial transaction with the customer's financial institution using at least one of the electronic profile and the special rule, wherein the special rule identifies the manner in which the funds can be transferred from the customer's financial institution (Paragraph 0088, lines 4-8.)

22. With respect to claim 18, Templeton et al. teaches identifying the special rule includes identifying that the financial transaction requires printing of a paper drafted check (Paragraph 0160, lines 1-7.)

23. With respect to claim 19, Templeton et al. teaches printing the paper drafted check includes printing a drop-to-draft check (Paragraph 0160, lines 1-7.)
24. With respect to claim 20, Templeton et al. teaches requesting settlement of the financial transaction comprises submitting the printed paper drafted check to the clearing house to settle the financial transaction (Paragraph 0160, lines 1-10.)
25. With respect to claim 21, Templeton et al. teaches identifying the special rule includes identifying that the financial transaction requires the use of a direct electronic access system Paragraph 0089, lines 8-12, Paragraph 0058, lines 9-14.)
26. With respect to claim 22, Templeton et al. teaches requesting settlement of the financial transaction comprises submitting the electronic profile to the customer's financial institution using the direct electronic access system (Paragraph 0058, lines 9-14.)
27. With respect to claim 23, Templeton et al. teaches evaluating the special rules database includes evaluating pre-recorded electronic information relating to either the customer or the customer's financial institution (Paragraph 0086, lines 1-14.)
28. With respect to claim 24, Templeton et al. teaches evaluating the pre-recorded information comprises evaluating a previous check writing history relating to either the customer or the customer's financial institution (Paragraph 0089 lines 6-12.)
29. With respect to claim 25, Templeton et al. teaches identifying either the customer or the customer's financial institution associated with at least one of an account number, a routing number, and an alternative routing number (Paragraph 0081, lines 1-15.)

30. With respect to claim 26, Templeton et al. teaches the method further comprises generating a risk score indicative of the risk associated with the financial transaction (Paragraph 0093, lines 1-5).

31. With respect to claim 27, Templeton et al. teaches updating the special rules database in a manner so as to record previous electronic profiles relating the customer (Paragraph 0089, lines 1-13.)

32. With respect to claim 28, Templeton et al. teaches evaluating the electronic profile further comprises developing at least one special rule relating to at least the customer (Paragraph 0089, lines 1-13.)

33. With respect to claim 29, Templeton et al. teaches a system for resolving an electronic check transaction to transfer money from a customer's financial institution via an existing funds transfer entity in response to the customer providing a promissory payment to a merchant, the system comprising:

a transaction device which receives a promissory payment from the customer to the merchant, wherein the transaction device generates and transmits an electronic profile indicative of the promissory payment and routing information (Paragraph 0025, lines 1-15, Paragraph 0027, paragraph 0028, lines 5-14);
and a check approval service that has access to records of past electronic check transactions that receives the electronic profile, wherein the check approval service identifies an electronic route for obtaining access to the customer's account and either (i) submits the electronic profile to the existing funds transfer entity electronically for electronic transfer of the funds from the customer's

account, or (ii) initiates an alternative resolution strategy prior to submitting the electronic profile to the existing funds transfer entity electronically if the records of past electronic check transactions indicates that an electronic check transaction for the received electronic profile may not be successful (Paragraph 0102, lines 1-5.)

34. With respect to claim 30, Templeton et al. teaches the check approval service submits the electronic profile to the existing funds transfer entity electronically by submitting the electronic profile to an electronic check conversion entity of a federal banking clearing house (Paragraph 0157, lines 1-8.)

35. With respect to claim 31, Templeton et al. teaches the check approval service includes a special rules data base that contains identifiers identifying electronic profiles for which electronic check transaction may not be successful (Paragraph 0052, lines 1-25.)

36. With respect to claim 32, Templeton et al. teaches the special rules data structure includes indicators of alternative resolution strategies that will result in successful transfer of funds from the customer's account in response to the check approval service receiving the electronic profile (Paragraph 0103 lines 1-12.)

37. With respect to claim 33, Templeton et al. teaches the alternative resolution strategies include: printing a paper representation of the electronic profile and submitting the paper representation to an existing paper clearing house so as to initiate the transfer of money from the customer's financial institution; changing the routing information of the electronic profile so as to identify a new route for obtaining access to

the customer's account and submitting the changed electronic profile to the existing funds transfer entity electronically; and submitting the electronic profile to the customer's financial institution via an alternative funds transfer entity (Paragraph 0160, lines 1-10.)

38. With respect to claim 34, Templeton et al. teaches the check approval service changes the routing information to identify a new financial institution associated with the customer's financial institution that will receive and process the electronic profile (Paragraph 0124, lines 1-15.)

39. With respect to claim 35, Templeton et al. teaches the check approval service submits the electronic profile via an alternative funds transfer entity by submitting the electronic profile directly to the customer's financial institution bypassing the existing funds transfer entity (Paragraph 0106, lines 1-16.)

40. With respect to claim 36, Templeton et al. teaches the check approval service includes an administrative component that when an electronic profile is submitted to the existing funds transfer entity electronically and the submission does not result in the transfer of funds from the customer's account, and wherein the administrative component attempts to develop an alternative resolution strategy that will result in subsequent transfer of funds for similar transactions (Paragraph 0094, lines 10-32.)

41. With respect to claim 37, Templeton et al. teaches the administrative component tracks the customer, if the records of past electronic check transactions indicates that an electronic check transaction for the received electronic profile may not be successful, by storing the customer's electronic profile in a customer list so as to develop the

alternative resolution strategy for future financial transactions involving the customer (Paragraph 0094, lines 10-32.)

42. With respect to claim 38, Templeton et al. teaches the administrative component develops the alternative resolution strategy by contacting financial institutions associated with the customer's account so as to identify alternate routing mechanisms for transferring funds from the customer's account (Paragraph 0094, lines 20-32.)

43. With respect to claim 39, Templeton et al. teaches developing the alternative resolution strategy includes reviewing the electronic profile for mistakes, reviewing the electronic profile for pattern matching, reviewing an image of the electronic profile, settlement via On-Us transaction, contacting the customer, and contacting the merchant, contacting the financial institution (Paragraph 0081, lines 1-15, Paragraph 0088, lines 1-14.)

44. With respect to claim 40, Templeton et al. teaches the alternate routing strategy includes the use of at least one of an alternate account routing number, an alternate routing number, a paper clearing house routing system, a direct electronic access routing system for transferring funds from the customer's account (Paragraph 0102, lines 1-5, Paragraph 0157, lines 1-9.)

45. With respect to claim 41, Templeton et al. teaches the administration component records the developed alternative resolution strategy in a retrievable manner so that the developed alternative resolution strategy can be used in future transactions involving the customer (Paragraph 0052, lines 12-20, Paragraph 0054, Paragraph 0055.)

46. With respect to claim 42, Templeton et al. the administration component re-submits the electronic profile using the developed alternative resolution strategy to determine if similar transactions involving the customer will result in subsequent transfer of funds (Paragraph 0105.)

47. With respect to claim 43, Templeton et al. teaches a method for resolving an electronic check transaction to transfer money from a customer's financial institution via an existing funds transfer entity in response to the customer providing a promissory payment, the method comprising:

- receiving a promissory payment from the customer (Paragraph 0025);
- generating an electronic profile indicative of the promissory payment;
- transmitting the electronic profile (Paragraph 0025);
- accessing records of past electronic check transactions (Paragraph 0052);
- identifying routing information for obtaining access to the customer's account;
- submitting the electronic profile to the existing funds transfer entity electronically for electronic transfer of funds from the customer's financial institution if it is determined that the records of past electronic check transactions indicates that an electronic check transaction for the received electronic profile will be successful (Paragraph 0106);
- and initiating an alternative resolution strategy prior to submitting the electronic profile to the existing funds transfer entity electronically if it is determined that the records of past electronic check transactions indicates that an electronic check

transaction for the received electronic profile may not be successful (Paragraph 0106.)

48. With respect to claim 44, Templeton et al. teaches submitting the electronic profile to the existing funds transfer entity electronically includes submitting the electronic profile to an electronic check conversion entity of a federal banking clearing house (Paragraph 0157, lines 1-8.)

49. With respect to claim 45, Templeton et al. teaches identifying electronic profiles for which electronic check transaction may not be successful (Paragraph 0052, lines 1-25.)

50. With respect to claim 46, Templeton et al. teaches identifying electronic profiles includes identifying alternative resolution strategies that will result in successful transfer of funds from the customer's account in response to receiving the electronic profile (Paragraph 0053.)

51. With respect to claim 47, Templeton et al. teaches identifying alternative resolution strategies include at least one of: printing a paper representation of the electronic profile and submitting the paper representation to an existing paper clearing house so as to initiate the transfer of money from the customer's account; changing the account information of the electronic profile so as to identify a new account number for obtaining access to the customer's account and submitting the changed electronic profile to the existing funds transfer entity electronically; changing the routing information of the electronic profile so as to identify a new route for obtaining access to the customer's account and submitting the changed electronic profile to the existing

funds transfer entity electronically; and submitting the electronic profile to the customer's financial institution via an alternative funds transfer entity (Paragraph 0160, lines 1-7.)

52. With respect to claim 48, Templeton et al. teaches changing the routing information to identify a new financial institution branch associated with the customer's financial institution that will receive and process the electronic profile (Paragraph 0053.)

53. With respect to claim 49, Templeton et al. teaches submitting the electronic profile via an alternative funds transfer entity includes submitting the electronic profile directly to the customer's financial institution bypassing the existing funds transfer entity (Paragraph 0066.)

54. With respect to claim 50, Templeton et al. teaches developing an alternative resolution strategy that will result in subsequent transfer of funds for similar transactions if submitting the electronic profile to the existing funds transfer entity does not result in the transfer of funds from the customer's account (Paragraph 0081.)

55. With respect to claim 51, Templeton et al. teaches tracking the customer's transactions, if the records of past electronic check transactions indicates that an electronic check transaction for the received electronic profile may not be successful, by storing the customer's electronic profile in a customer list so as to develop the alternative resolution strategy for future financial transactions involving the customer (Paragraph 0094, lines 10-32.)

56. With respect to claim 52, Templeton et al. teaches developing the alternative resolution strategy includes contacting financial institutions associated with the customer's account so as to identify alternate routing mechanisms for transferring funds

Art Unit: 4137

from the customer's account (Paragraph 0052, Paragraph 0053, Paragraph 0071, lines 1-10.)

57. With respect to claim 53, Templeton et al. teaches identifying alternate routing mechanisms includes identifying at least one of an alternate account routing number, an alternate branch routing number, a paper clearing house routing system, and a direct electronic access routing system (Paragraph 0049, lines 1-10, Paragraph 0052, Paragraph 0053, Paragraph 0054, lines 7.)

58. With respect to claim 54, Templeton et al. teaches recording the developed alternative resolution strategy in a retrievable manner so that the developed alternative resolution strategy can be used in future transactions involving the customer (Paragraph 0081.)

59. With respect to claim 55, Templeton et al. teaches submitting the electronic profile using the developed alternative resolution strategy to determine if similar transactions involving the customer will result in subsequent transfer of funds (Paragraph 008, lines 7-14.)

Claim Rejections - 35 USC § 103

60. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

61. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Templeton et al. in view of Allan (US 2003/0055756.)

62. With respect to claim 14, Templeton et al. teaches submitting the customer's electronic representation to the customer's financial institution directly comprises transferring funds from the customer's account direct connect, On-Us processing. However, Templeton et al. does not direct show account direct connecting, On-us processing. Allan teaches an On-us transaction (Page 4, paragraph 0040.) Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Templeton et al. taught by Allan and include Allan's On-us transaction in Templeton et al.

Conclusion

63. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Templeton et al. (US Pub 2003/0130919) teaches direct access. Allan (US Pub. 2003/0055756) teaches direct access, an On-us transaction.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571)270-5211. The examiner can normally be reached on Monday through Thursday 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L Hewitt can be reached on 5712726709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HIEP NGUYEN/
Examiner, Art Unit 4137

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 4137